

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 10/728,982
ATTORNEY DOCKET NO. Q78732

AMENDMENTS TO THE DRAWINGS

Applicants herein amend the Drawings as suggested by the Patent Office in the July 12, 2005 Office Action. Applicants submit that the objection to the Drawings has been overcome, and respectfully request that the objection be withdrawn.

Attachment: Two (2) Replacement Sheets

REMARKS

Applicants thank the Patent Office for acknowledging Applicants' claim to foreign priority, and for indicating that the certified copy of the priority document, European Patent Application No. 02293228.9 dated December 23, 2002, has been made of record in the file.

Applicants thank the Patent Office for initialing the references listed on the PTO/SB/08 A & B form submitted with the Information Disclosure Statement filed on December 8, 2003, thereby confirming that the listed references have been considered.

Claims 1-10 have been examined on their merits.

Applicants herein cancel claims 9 and 10 without prejudice and/or disclaimer.

Applicants herein add new claims 11-16. Entry and consideration of the new claims 11-16 is respectfully requested.

Claims 1-8 and 11-16 are all the claims presently pending in the application.

1. The Patent Office objected to claims 1-10 as containing informalities. Applicants herein amend claims 1-10 to remove the informalities, and respectfully request that the objection to claims 1-10 be withdrawn.

With respect to the Patent Office's objection to the use of phrase "integrated-circuit-environment" in the claims, this phrase has been adequately defined in the disclosure at page 7, and therefore it is unnecessary to remove it from the claims.

2. Claims 1-5 and 8-10 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Godlew *et al.* (U.S. Patent No. 5,377,196) in view of Ueno *et al.* (U.S. Patent No. 5,592,628). The rejection of claims 9 and 10 is now moot due to their cancellation. Applicants respectfully traverse the § 103(a) rejection of claims 1-5 and 8 for at least the reasons discussed below.

The combination of Godlew *et al.* and Ueno *et al.* fails to teach or suggest at least a computer program product comprising a generic module and a specific module, as recited in amended claim 1. With respect to Godlew *et al.*, the Patent Office points to a generic module (214A), a rule module (214B), a measurement module (214C), a remote module (214D) and a user question module (214E) as disclosing the generic and specific modules recited in amended claim 1. However, the generic module recited in claim 1 is used to allow the computer program product to interface with an integrated-circuit-environment, and the specific module provides a transmission protocol specific to the integrated-circuit-environment to the generic module. There is no teaching or suggestion in Godlew *et al.* that the various modules identified by the Patent Office provide each other with transmission protocols specific to an integrated-circuit-environment under test.

Ueno *et al.*, when combined with Godlew *et al.*, does not overcome the deficiencies of Godlew *et al.* as discussed above. Ueno *et al.* disclose, *inter alia*, the use of multiple transfer buffers between two processors. The combination of Godlew *et al.* and Ueno *et al.* does not teach or suggest at least a generic module that allows a computer program product to interface with an integrated-circuit-environment, and a specific module that provides a transmission

protocol specific to the integrated-circuit-environment to the generic module, as recited in amended claim 1. Neither of the references teaches or suggests the use of specific modules to provide transmission protocols to a generic transmission module in order to provide interfacing capability to different integrated-circuit-environment under test. Thus, Applicants submit that the combination of Godlew *et al.* and Ueno *et al.* fail to meet the “all limitations” prong of a *prima facie* case of obviousness with respect to claim 1.

Applicants submit that one of ordinary skill in the art would not be motivated to combine Godlew *et al.* with Ueno *et al.* to arrive at the present invention, since neither reference teaches or suggests the use of specific modules to provide transmission protocols to a generic transmission module in order to provide interfacing capability to different integrated-circuit-environment under test. Thus, Applicants submit that the combination of Godlew *et al.* and Ueno *et al.* fail to meet the motivation prong of a *prima facie* case of obviousness with respect to claim 1.

Based on at least the foregoing reasons, Applicants submit that claim 1 is in condition for allowance over the combination of Godlew *et al.* and Ueno *et al.*, and further submit that claims 2-5 are allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 1-5.

With respect to independent claim 8, Applicants submit that claim 8 is in condition for allowance over the combination of Godlew *et al.* and Ueno *et al.* for at least reasons analogous to those discussed above with respect to claim 1. Applicants further submit that new claims 11-15

are allowable as well, at least by virtue of their dependency from claim 8. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 8.

With respect to new independent claim 16, Applicants submit that claim 16 is in condition for allowance over the combination of Godlew *et al.* and Ueno *et al.* for at least reasons analogous to those discussed above with respect to claim 1.

3. Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Godlew *et al.* in view of Ueno *et al.*, and in further view of Dun *et al.* (U.S. Patent Publication No. 2003/0229827). Applicants respectfully traverse the § 103(a) rejection of claims 6 and 7 for at least the reasons discussed below.

Claims 6 and 7 depend from claim 1, and therefore include all its recitations by virtue of its dependency. Dun *et al.* do not provide any additional disclosure that would overcome the deficiencies of the combination of Godlew *et al.* and Ueno *et al.* as discussed above with respect to claim 1. Therefore, Applicants submit that claims 6 and 7 are allowable over the combination of Godlew *et al.*, Ueno *et al.* and Dun *et al.* at least by virtue of their dependency from claim 1.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

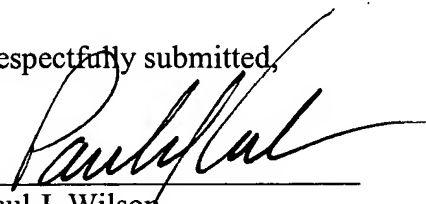
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Respectfully submitted,



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Date: September 30, 2005